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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,342	11/23/2001	Helmut Wollschlager	APV31160B	2262

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EXAMINER

WILLIAMS, CATHERINE SERKE

ART UNIT	PAPER NUMBER
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3763

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DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,342

Applicant(s)

WOLLSCHLAGER, HELMUT

Examiner

Catherine S. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 4-23, 26-42 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☒ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Figure 1 and claims 1-3, 24-25 and 43 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the species of figures 1-3 have a common feature in that the bypass section is located outside the body and therefore it would not be an undue burden to search all three species. This is not found persuasive because while the three species may have bypass sections that are located outside the body, each bypass section is configured in different locations on the proximal end of the guide catheter. Each embodiment has a distinct structure, is disclosed by applicant to be different embodiments and is considered to be patentably distinct. See brief description of drawings page 10 of specification. If applicant believes these species to be not patentably distinct then applicant should indicate the species as such.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4-23, 26-42 and 44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim Objections

Claims 1, 24 and 25 are objected to because of the following informalities:

In claim 1:

-the recitation of "the largest cross section" should be --a largest cross section--,

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-the recitation of "the hydraulic cross section" should either be – a hydraulic bypass cross section – or – a bypass cross section –,

In claim 24:

-the recitation of "the largest cross section" should be –a largest cross section--,

-the recitation of "the hydraulic cross section" should either be – a hydraulic bypass cross section – or – a bypass cross section –,

In claim 25:

-the recitation of "the area" should be –an area--,

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-25 and 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24 and 43 are indefinite because the claims read as a long preamble with no transitional phrases. Transitional phrases (i.e. "comprising", "consisting essentially of" and "consisting of" define the scope of a claim. Without a transitional phrases one cannot determine the meets and bounds of the claim; one cannot determine what elements or limitations are a part of the apparatus or method.

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Additionally, the string of "wherein" clauses that are replete within claims 1, 24 and 43, while not rendering the claims indefinite, make the claims difficult to read and rapidly understand. It is suggested, so that one may rapidly understand the limitations of the claims, that the claim limitations be set forth positively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 24-25 are rejected under 35 U.S.C. 103(a) as obvious over McNamara in view of Cohen et al (US Pat# 5,167,239). McNamara discloses a device that includes a valve unit (60), a guide catheter (26) and a bypass section (30,46). As shown, an instrument can be inserted through the valve unit into the guide catheter. The wall of the guide catheter is close fitting for the guidewire (instrument) and the bypass section is larger than the lumen cross section, see figure 2. The length of the bypass section (46) is at least as long as the "J" shaped tip of the guidewire. However, McNamara does not disclose a guidewire with a largest cross section.

Cohen discloses an anchorable guidewire. The device includes an elongate body (12), inflatable balloon (14) and an additional infusion lumen (see 5:59+).

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At the time of the invention, it would have been obvious to substitute the guidewire of McNamara with the guidewire of Cohen. Both devices are analogous in the art and with the claimed invention; therefore, a combination is proper. Additionally, the guidewire of Cohen would provide the device of McNamara with a guidewire that could not only dissolve an occlusion within a vessel but also (i) anchor within the clot once partially dissolved and (ii) dilate a region of the clot for enhanced performance in clot removal. The motivation for the substitution can be found within the McNamara reference. Specifically, the objective of McNamara is "to provide for the extension of the infusion segment through the obstruction as the obstruction being treated dissolves or opens up". See 2:28-31. The guidewire of Cohen will help facilitate this objective by enabling the device of McNamara to anchor within the dissolved clot and help dilate any opening in the clot.

Allowable Subject Matter

Claim 43 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

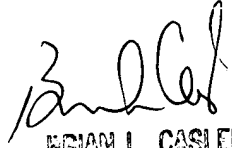
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine S. Williams whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.

Catherine S. Williams *CSW*
December 7, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
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